



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTORNEY DOCKET NO. 049212-0103

Applicants: Bruce BENT et al.

Title: MONEY FUND BANKING SYSTEM WITH MULTIPLE BANKS AND/OR RATES

Appl. No.: 09/677,535

Filing Date: 10/02/2000

Examiner: Daniel S. Felten

Art Unit: 3696

Confirmation Number:
4334

INFORMATION DISCLOSURE STATEMENT
UNDER 37 CFR §1.56

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith on Form PTO/SB/08 is a listing of documents known to Applicants in order to comply with Applicants' duty of disclosure pursuant to 37 CFR §1.56.

A copy of each non-U.S. patent document and each non-patent document is being submitted to comply with the provisions of 37 CFR §1.97 and §1.98.

The submission of any document herewith, which is not a statutory bar, is not intended as an admission that such document constitutes prior art against the claims of the present application or that such document is considered material to patentability as defined in 37 CFR §1.56(b). Applicants do not waive any rights to take any action which would be appropriate to antedate or otherwise remove as a competent reference any document which is determined to be a *prima facie* art reference against the claims of the present application.

TIMING OF THE DISCLOSURE

The listed documents are being submitted in compliance with 37 CFR §1.97(b), concurrently with the filing of a Request for Continued Examination (RCE) application

RELEVANCE OF EACH DOCUMENT

All of the documents are in English.

Applicants respectfully request that each listed document be considered by the Examiner and be made of record in the present application and that an initialed copy of Form PTO/SB/08 be returned in accordance with MPEP §609.

STATEMENT

Applicants' representative was notified by the firm of Amster, Rothstein & Ebenstein LLP, acting as litigation counsel for the assignee Island Intellectual Property LLC (defined as "Island IP") and one of Island IP's exclusive licensees, LIDs Capital LLC ("LIDs"), and LIDs sublicensee, Double Rock Corporation, collectively, "the Island IP Parties," that on the morning of Tuesday, March 24, 2009, the Island IP Parties brought two lawsuits to enforce U.S. Patent No. 7,509,286 (a continuation-in-part of U.S. Patent No. 6,374,231 patent currently in reissue) against several accused infringers in the U.S. District Court for the Southern District of New York, case nos. 09 CV 2675 (**IDS Item E60**), and 09 CV 2677 (**IDS Item E61**).

After representatives of each of the defendants were notified of the above-listed lawsuits a separate suit was filed by Promontory Interfinancial Network, LLC, ("Promontory"), one of the defendants, in the above-listed suits, at 1:05 pm of the same day, March 24, 2009, in the U.S. District Court for the Eastern District of Virginia. The suit in the Eastern District of Virginia against Island IP and Double Rock Corporation relates to U.S. Patent No. 6,374,231 (currently reissue application 10/825,440) and U.S. Patent No. 7,509,286, with counts of non-infringement, invalidity, unenforceability, as well as Federal

and state tort claims (**IDS Item E62**). An amended complaint was filed on March 27, 2009 (**IDS Item E63**) adding LIDs Capital LLC as a party. The applicants respectfully submit that these claims are unfounded.

Applicants' representative was notified by the firm of Amster, Rothstein & Ebenstein LLP, that on Tuesday, April 14, 2009, the Island IP Parties and an affiliate Intersweep LLC, brought a lawsuit to enforce U.S. Patent No. 7,519,551 (a continuation-in-part of U.S. Patent No. 6,374,231 patent currently in reissue and a continuation-in-part of serial no. 09/677,535) against several accused infringers in the U.S. District Court for the Southern District of New York, case no. 09 CV 3750 (**IDS Item E64**).

A separate suit was filed by Promontory Interfinancial Network, LLC, ("Promontory"), one of the defendants, in the suit to enforce U.S. Patent No. 7,519,551, on the same day, April 14, 2009, in the U.S. District Court for the Eastern District of Virginia. The suit in the Eastern District of Virginia against the Island IP Parties relates to U.S. Patent No. 7,519,551, with counts of non-infringement, invalidity, unenforceability (**IDS Item E65**). On April 15, 2009, Promontory filed an amended complaint adding Intraweepl as a defendant (**IDS Item E66**).

The Virginia complaint against U.S. Patent No. 6,374,231 and the Virginia complaint against U.S. Patent No. 7,519,551, lists items of prior art as allegedly being withheld. In this respect, an attorney for Promontory has been sending letters to the firm of Amster, Rothstein & Ebenstein LLP, identifying prior art, with copies to applicants' representative, timed to arrive after a Notice of Allowance and/or issue fees had been paid in co-pending applications of the applicants. Each of the items of prior art listed in the Virginia suit had previously been disclosed in the reissue application, in information disclosure statements (IDSs), as follows:

On sale activity by Assignee alleged for claims in the reissue application 10/825,440 (referenced in paragraph 71 of E62, paragraph 72 of E63 and paragraph 46 of E65)—disclosed in IDS of March 2, 2007, E6, for reissue 10/825,440, and filed with an Amendment on March 1, 2007, for the present case.

1983 CMA/ISA Service (referenced in paragraph 72 of E62, paragraph 73 of E63 and paragraphs 43 and 60 of E65)—disclosed in IDS of September 26, 2008, H38, for reissue 10/825,440, and in the IDS of September 3, 2008, D14, for the present case.

William W. Wiles ltr of June 22, 1983 (referenced in paragraph 73 of E62, paragraph 74 of E63 and paragraph 63 of E65)—disclosed in IDS of September 26, 2008, H38, for reissue 10/825,440, and in the IDS of September 3, 2008, D14, for the present case.

Michael Bradford ltr of November 16, 1984 (referenced in paragraph 73 of E62, paragraph 74 of E63 and paragraph 63 of E65)—disclosed in IDS of September 26, 2008, H42, for reissue 10/825,440, and in the IDS of September 3, 2008, D18, for the present case.

Oliver I. Ireland ltr of June 22, 1988 (referenced in paragraph 73 of E62, paragraph 74 of E63 and paragraph 63 of E65)—disclosed in IDS of September 26, 2008, H44, for reissue 10/825,440, and in the IDS of September 3, 2008, D20, for the present case.

Oliver I. Ireland ltr of August 1, 1995 (referenced in paragraph 73 of E62, paragraph 74 of E63 and paragraph 63 of E65)—disclosed in IDS of December 15, 2008, J3, for reissue 10/825,440, and in the IDS filed herewith as item E92.

Oliver I. Ireland ltr of August 30, 1995 (referenced in paragraph 73 of E62, paragraph 74 of E63 and paragraph 63 of E65)—disclosed in IDS of December 15, 2008, J4, for reissue 10/825,440, and in the IDS filed herewith as item E95.

Oliver I. Ireland ltr of October 18, 1996 (referenced in paragraph 73 of E62, paragraph 74 of E63 and paragraph 63 of E65)—disclosed in IDS of December 15, 2008, J1, for reissue 10/825,440, and in the IDS filed herewith as item E93.

2000 CMA 2.0 Service (referenced in paragraphs 44, 90 and 91 of E62, paragraphs 45, 91 and 92 of E63 and paragraphs 47, 61 and 62 of E65)—disclosed in IDS of March 23, 2009, K10, K11, for reissue 10/825,440, and in the IDS of March 3, 2009, L1 and L2, for 10/071,053, and in the IDS filed herewith as items E98 and E99.

The Virginia complaint makes reference to alleged misstatements regarding the prior art. With the single exception of the item that will be discussed below, all alleged misstatements have been addressed in the respective applications involved.

In application serial no. 10/071,053, now U.S. Patent No. 7,519,551, when an attorney for Promontory provided two references to the firm of Amster, Rothstein & Ebenstein LLP on February 23, 2009 with a copy to the undersigned, relating to a Merrill Lynch banking product for year 2000, due inquiry before submission was made of applicants, and then an IDS with a certification according to 37 CRF 1.97(e)(2) was filed on 3/03/09, disclosing these two references, L1 and L2, in the IDS of March 3, 2009, for 10/071,053, after the issue fee had been paid for serial no. 10/071,053. Applicants' representative considers these references to be cumulative to what was previously submitted and not material to the claims of serial no. 10/071,053 for the reasons cited in the 3/03/09 IDS, and thus did not file an RCE and Petition in that case.

However, with respect to application serial no. 10/071,053, the Virginia complaint filed by Promontory Interfinancial Network, LLC, indicated that Bruce Bent II, one of the inventors of the patents and applications, had made comments about a new Merrill Lynch product in the article On Wall Street on November 1, 2000. Upon further inquiry, Mr. Bent, again stated that he had never seen the documents disclosed by the defendants attorney, but did state that he was aware of the Merrill Lynch product. Accordingly, some information in the specific documents, L1 and L2, in the IDS of March 3, 2009, for 10/071,053, was known to applicants more than 3 months before disclosure of those particular documents in the March 3, 2009 IDS that was not considered by the examiner, making the certification arguably incorrect in serial no. 10/071,053. However, that information had been previously disclosed more than 2 years earlier at least in items D11 and D15 in the IDS of October 20, 2006 filed in application serial no. 10/071,053, that was considered by the examiner.

In the present application, the references identified by the attorney for Promontory are disclosed in the present IDS, E98 and E99. The cumulative references disclosed previously are disclosed in the IDS of October 20, 2006, A13 and A17.

The examiner should be aware that the following co-pending patent applications disclosed in an IDS relate to similar kinds of products, although the claims are clearly patentably distinct. The most recent action for these applications is listed.

10/825,440 filed 04-14-04 (03/25/09 Advisory Office Action rejection)

09/677,535 filed 10-02-00 (07/22/08 Notice of Allowance –Proposed amendment filing –Petition to Withdraw to file IDS and Amendment – Dismissal of Petition – Petition Renewed.) (Present case).

10/071,053 filed 02-08-02 (Issued as U.S. Patent No. 7,519,551)

10/305,439 filed 11-26-02 (05/02/08 Response filed to non-final rejection)

11/149,278 filed 06-10-05 (12/19/08 Office Action rejection received)

10/382,946 filed 03-06-03 (Issued as U.S. Patent No. 7,536,350)

10/411,650 filed 04-11-03 (Issued as U.S. Patent No. 7,509,286)

11/641,046 filed 12-19-06 (02/19/09 Office Action with rejection)

11/689,247 filed 03-21-07 (02/02/09 Office Action with rejection)

11/767,827 filed 06-25-07 (03/06/09 Office Action with rejection)

11/767,837 filed 06-25-07 (02/05/09 Office Action with rejection)

11/767,846 filed 06-26-07 (02/25/09 Office Action with rejection)

11/767,856 filed 06-25-07 (02/25/09 Office action with rejection)

11/840,064 filed 08-16-07 (10/15/08 Office Action with rejection)

11/840,060 filed 08-16-07 (Response filed 12/09/08 to Office Action with rejection)

11/840,052 filed 08-16-07 (Response filed 12/11/08 to Office Action with rejection)

11/932,762 filed 10-31-07 (Response filed 11/24/08 to Office Action with rejection)

12/271,705 filed 11-14-08 (03/20/09 Office action with rejection)

12/025,402 filed 02-04-08

12/340,026 filed 12-19-08

12/408,507 filed 03-20-09

12/408,511 filed 03-20-09

12/408,523 filed 03-20-09

The examiner is directed to review the file of these other co-pending applications as he/she deems appropriate, to determine the reasoning and references applied in the current and/or prior office actions, as well as applicants' responses thereto.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Applicants respectfully request that each listed document be considered by the Examiner and be made of record in the present application and that an initialed copy of Form PTO/SB/08 be returned in accordance with MPEP §609.

Although Applicants believe that no fee is required for this Request, the Commissioner is hereby authorized to charge any additional fees which may be required for this Request to Deposit Account No. 19-0741.

Respectfully submitted,



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May 14, 2009

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